

Appl. No. 10/663,990  
Amendment dated March 17, 2005  
Reply to Office Action of December 29, 2004

## **REMARKS**

In the December 29, 2004 Office Action, claims 1-4, 6-12, 14, 16-18, 20 and 22 stand rejected in view of prior art, while claims 5, 13, 15, 19, 21 and 23 and were withdrawn as being drawn to a nonelected invention. Claims 2-4, 6, 7 and 22 also were rejected for failing to indicate and claim particularly and distinctly the subject matter that Applicants regard as the invention. No other objections or rejections were made in the Office Action.

### ***Status of Claims and Amendments***

Applicants have amended the claims as indicated above. Thus, claims 1-26 are pending, with claims 5, 13, 15, 19, 21 and 23 being withdrawn. Reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

### ***Interview Summary***

On February 16, 2005, the undersigned conducted a personal interview with Examiner DePumpo, who is in charge of the above-identified patent application. During the interview, a brief discussion of the invention was given by the undersigned. The prior art as it relates to the claims was discussed. Specifically, the patentable weight given to the terms "configured" and "dimensioned" and the applicability of the cited prior art was discussed. Applicants wish to thank Examiner DePumpo for the opportunity to discuss the above-identified patent application during the Interview of February 16, 2005.

### ***Election of Species***

In paragraph 1 of the Office Action, Applicants' election without traverse in the response filed on November 1, 2004 was acknowledged. Thus, non-elected claims 5, 13, 15, 19 and 21 were withdrawn from further consideration. However, Applicants respectfully request that non-

elected claims 5, 13, 15, 19 and 21 be rejoined in this application upon allowance of a generic claim.

***Claim Rejections - 35 U.S.C. §112***

In paragraph 4 of the Office Action, claims 2-4, 6, 7 and 22 were rejected under 35 U.S.C. §112, second paragraph. In response, Applicants have amended claim 22.

The Office Action states that claim 2 “appears to be incorrect because the cap portion is outside of the steering tube, and not “within” the steering tube.” Applicants respectfully submit that claim 2 is correct. Referring to Figures 4 and 6, a lower section 61b of the cap portion 61 is located within the steer tube 46. Support can also be found in the specification, for example at paragraph [0040].

Applicants have amended claim 22 to correct the lack of antecedent basis. Specifically, the “cap portion” has been changed to the “housing portion.”

Applicants believe that the claims now comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested.

***Rejections - 35 U.S.C. § 102***

In paragraph 6 of the Office Action, claims 1, 2, 7, 8, 10-12, 15 and 16 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,616,165 (Tsuji).

Independent claim 1 recites; *inter alia*, a housing portion that is configured and dimensioned to form an electrical part receiving space that is located ***within*** the ***steerer*** tube of a ***bicycle*** fork. This structure is ***not*** disclosed or suggested by Tsuji or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference.

Tsuji is directed to a motor scooter and discloses a cover 38 that closes a box 27. The Office action states that the terms “dimensioned” and “configured” do not provide structure

that defines over Tsuji. Applicants respectfully disagree with this assertion. Even if the terms are considered functional language, the Federal Circuit clearly held in *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990) that functional language cannot be disregarded.

Applicants respectfully submit that the terms “dimensioned” and “configured” limit the housing portion such that it must, at the very least, be *capable of* forming an electrical part receiving space **within a steerer tube of a bicycle fork**. The box 27 of Tsuji is much larger than a steerer tube of a bicycle fork and is therefore configured and dimensioned such that it is *incapable of* forming an electrical receiving space **within a steerer tube of a bicycle fork**. Therefore, Applicants respectfully submit that, for at least these reasons, claim 1 is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

In paragraph 7 of the Office Action, claims 1-4, 7-10, 12 and 15-18 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,303,248 (Peterson).

Independent claim 1 recites, *inter alia*, a cap portion that is dimensioned to close a top **opening of a steerer tube of a bicycle fork**. Independent claim 1 further recites a housing portion that is configured and dimensioned to form an electrical part receiving space that is located **within the steerer tube of a bicycle fork**. This structure is **not** disclosed or suggested by Peterson or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference.

Peterson is directed to a solderless battery pack having a battery cell holding sleeve 22, 23 between a top end cap 42 and a bottom end cap 40. The Office action states that the terms “dimensioned” and “configured” do not provide structure that defines over Peterson.

Applicants respectfully submit that the term “dimensioned” limits the cap portion such that it must, at the very least, be *capable of* closing a top ***opening*** of a ***steerer tube*** of a ***bicycle fork***. The general size and oblong shape of the top end cap 42 of Peterson is *incapable of* closing a top ***opening*** of a ***steerer tube*** of a ***bicycle fork***.

Moreover, Applicants respectfully submit that the terms “dimensioned” and “configured” limit the housing portion such that it must, at the very least, be *capable of* forming an electrical part receiving space ***within*** a ***steerer tube*** of a ***bicycle fork***. The battery cell holding sleeves 22, 23 and the bottom cap 40 of Peterson are configured and dimensioned such that they are *incapable of* forming an electrical receiving space ***within*** a ***steerer tube*** of a ***bicycle fork***. Therefore, Applicants respectfully submit that, for at least these reasons, claim 1 is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

In paragraph 8 of the Office Action, claims 1-4, 6 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,431,575 (Campagnolo).

Independent claim 1 recites, *inter alia*, that the housing portion extends axially from the lower abutment surface of the cap portion. This structure is *not* disclosed or suggested by Campagnolo or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference.

Campagnolo discloses a cap 13 and a steerer tube 5. As illustrated in Figure 1 of Campagnolo, there is a space between cap 13 and steerer tube 5. Therefore, the steerer tube 5 does not extend axially from a lower abutment surface of cap 13. Accordingly, Campagnolo does not disclose a housing portion extending axially from the lower abutment surface of the

cap portion. Applicants respectfully submit that, for at least these reasons, claim 1 is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Independent claim 22 recites, *inter alia*, a housing portion having a first and second end. Claim 22 further recites a fixing bolt extending longitudinally **through** the housing portion ***between the first and second ends***.

Campagnolo discloses a bolt 15 that extends through the cap 13 and into the steerer tube 5. The bolt 15 does not extend through the steerer tube 5 between first and second ends. Therefore, Campagnolo does not disclose a fixing bolt that extends longitudinally **through** the housing portion ***between the first and second ends***. Applicants respectfully submit that, for at least these reasons, claim 22 is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

In paragraph 9 of the Office Action, claims 1-4, 6, 8-10, 12, 15-18, 20 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,435,983 (Shimano).

Independent claim 1, recites, *inter alia*, the housing portion is configured and dimensioned with an outer maximum width that is **smaller** than an annular steerer tube space that is projected from a peripheral edge of the lower abutment surface of the cap portion and surrounding the housing portion. This structure is **not** disclosed or suggested by Shimano or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference.

Shimano discloses a handle stem for a bicycle having a cap 11, a stem body 1 and a projecting portion 2. The stem body 1 has an outer maximum width that is **larger** than that of the cap 11. Therefore, Shimano does not disclose a housing portion that is configured and

dimensioned with an outer maximum width that is *smaller* than an annular steerer tube space that is projected from a peripheral edge of the lower abutment surface of the cap portion and surrounding the housing portion. Applicants respectfully submit that, for at least these reasons, claim 1 is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Independent claim 22 recites, *inter alia*, a housing portion having a first and second end. Claim 22 further recites a fixing bolt extending longitudinally *through* the housing portion *between the first and second ends*.

Shimano discloses an expander bolt 13 in a stem body 1. The expander bolt 13 does not extend through the stem body 1 between first and second ends. Therefore, Shimano does not disclose a fixing bolt that extends longitudinally *through* the housing portion *between the first and second ends*. Applicants respectfully submit that, for at least these reasons, claim 22 is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Moreover, Applicants believe that the dependent claims are also allowable over the prior art of record in that they depend from independent claims 1 and 22, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not anticipate independent claims 1 and 22, neither does the prior art anticipate the dependent claims.

Applicants respectfully request withdrawal of the rejections.

***Prior Art Citation***

In the Office Action, additional prior art references were made of record. Applicants believe that these references do not render the claimed invention obvious.

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***Conclusion***

In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-22 and 24-26 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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